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DEC 0 8 2003

OFFICE OF PETITIONS

In re Application of
Barry Schwab
Application No. 09/846,933
Filed: May 1, 2001
Attorney Docket No. TTI-102-D
[12209.11242]
Title: SECURE INTERACTIVE DIGITAL SYSTEM FOR DISPLAYING ITEMS TO A USER IDENTIFIED AS HAVING PERMISSION TO ACCESS THE SYSTEM

DECISION ON PETITION
UNDER 37 C.F.R. §1.137(a)

This is a decision on the petition filed on November 10, 2003, pursuant to 37 C.F.R. §1.137(a)[1], to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (notice), mailed August 31, 2001, which set a shortened statutory period for reply of two (2) months. The notice set forth that a properly executed oath or declaration in compliance with 37 C.F.R. §1.63, a surcharge for its late filing, and substitute drawings were required to avoid abandonment. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on November 1, 2001.

The instant petition lacks items (1) and (3) above.

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1 A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

(1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);

(2) the petition fee;

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;

(4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

Regarding the first requirement above, petitioner has failed to supply a required reply. The notice indicated that an executed oath or declaration, the associated surcharge, and substitute drawings were required. With the instant petition, none of these items have been located in the file[2].

Regarding the third requirement above, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard

35 USC §133 states, "Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable." (emphasis added)

"In the specialized field of patent law, ... the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference."[3].

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[4]

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[5]

Nonawareness of a PTO rule will not constitute unavoidable delay[6]

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2 Petitioner sets forth that copies of the check and the declaration were submitted with the instant petition, but such has not been located in the file. Furthermore, petitioner did not submit the fee associated with the late filing of an oath or declaration, or substitute drawings. Each of these three items was required by the notice.

3 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA)1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1425, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

4 Id.

5 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

6 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of

> The burden of showing the cause of the delay is on the person seeking to revive the application[7].
>
> A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action[8].

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present[9].

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account[10]."

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable[11]."

Application of the standard to the current facts and circumstances

With the instant petition, Petitioner has stated that on October 30, 2001, a declaration, a check, and a copy of the notice was submitted to the Office. Unfortunately, petitioner placed the wrong application number on the response. Petitioner states that this is apparent from the copies of the

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an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

7 Id.

8 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

9 In re Mattullath, 38 App. D.C. at (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

10 Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

11 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

check, postcard, and response,[12] and that it is "quite clear that the application became unavoidably abandoned[13]."

First, even if the Office had received these items and matched them with the file, the application would have gone abandoned due to the petitioner's failure to submit the substitute drawings, as required per the notice. Even with the renewed petition, petitioner does not address this requirement. It appears that petitioner has overlooked this requirement of the notice.

Secondly, Petitioner is a registered practitioner, and as such, surely understands that when a communication is submitted to the Office, it is matched to the application that corresponds to the application number listed on the communication. With a little diligence, it is believed that the petitioner would have realized that the wrong application number had been listed on the communication, upon comparing the communication to his file record, prior to mailing. While mistakes certainly occur, it does not appear that petitioner exhibited a level of diligence consistent with his most important business, and thus the inadvertent entry of an incorrect number certainly cannot rise to the level of "unavoidable".

Consequently, the petition is **DISMISSED**.

Any request for reconsideration must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR §1.137(a) (or *Renewed Petition under 37 C.F.R. §1.137(b), if applicable).*" This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Alternate venue

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR §1.137(b). A grantable petition pursuant to 37 CFR §1.137(b) must be accompanied by the required reply (already submitted), the required petition fee, and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR §1.137(b) was unintentional.

The filing of a petition under 37 CFR §1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR §1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR §1.137(b).

The reply to this letter may be submitted by mail[14], hand-delivery[15], or facsimile[16]. **Please note that the later two have changed, as of December 1, 2003.**

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12 Again, these copies have not been located in the application file.

13 Petition, page 2.

14 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450,

The change of correspondence address has been entered and made of record.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.

Paul Shanoski
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Office of Petitions
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16 (703) 872-9306.